

AF/2175\$

MAY 26 2004	TRANSMITTAL OF APPEAL BRIEF (Small Entity)	Docket No. NERE-2842
-------------	--	-------------------------

In Re: Application Of: Nerenberg et al.

Serial No. 09/584,610	Filing Date 5/31/2000	Examiner Rimell, S.	Group Art Unit 2175
--------------------------	--------------------------	------------------------	------------------------

Invention: DEATH VISUALIZATION THERAPY

RECEIVED
MAY 28 2004
Technology Center 2100

TO THE COMMISSIONER FOR PATENTS:

Transmitted herewith in triplicate is the Appeal Brief in this application, with respect to the Notice of Appeal filed on:

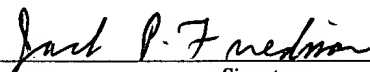
Applicant is a small entity under 37 CFR 1.9 and 1.27.

A verified statement of small entity status under 37 CFR 1.27:

- ☐ is enclosed.
- ☒ has already been filed in this application.

The fee for filing this Appeal Brief is: \$165.00


- ☒ A check in the amount of the fee is enclosed.
- ☐ The Director has already been authorized to charge fees in this application to a Deposit Account.
- ☒ The Director is hereby authorized to charge any fees which may be required, or credit any overpayment to Deposit Account No. 19-0513


Signature

Dated: 5/24/2004

Jack P. Friedman
Reg. No. 44,688
Schmeiser, Olsen & Watts
3 Lear Jet Lane, Suite 201
Latham, NY 12110
(518) 220-1850

I certify that this document and fee is being deposited on 5/24/2004 with the U.S. Postal Service as first class mail under 37 C.F.R. 1.8 and is addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.


Signature of Person Mailing Correspondence

CC:

Kim Dwileski
Typed or Printed Name of Person Mailing Correspondence



DOCKET NO. NERE-2842

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Nerenberg *et al.*

Examiner: Rimell, S.

Serial No.: 09/584,610

Art Unit: 2175

Filed: 5/31/00

For: **DEATH VISUALIZATION THERAPY**

RECEIVED

MAY 28 2004

Technology Center 2100

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

BRIEF OF APPELLANT

This Appeal Brief, pursuant to the Notice of Appeal filed March 29, 2004, is an appeal from the rejection of the Examiner dated January 18, 2004.

REAL PARTY IN INTEREST

Mental Heath Services, Inc. is the real party in interest.

RELATED APPEALS AND INTERFERENCES

None.

STATUS OF CLAIMS

Claims 1, 4-10, 12-17 and 19-21 are currently pending. Claims 1, 4-10, 12-17 and 19-21 have been rejected. This Brief is in support of an appeal from the rejection of claims 1, 4-10, 12-

09/584,610

1

05/27/2004 DEMMANU1 00000051 09584610

01 FC:2402

165.00 0P

17 and 19-21.

STATUS OF AMENDMENTS

There are no After-Final Amendments which have not been entered.

SUMMARY OF INVENTION

~~The present invention discloses a therapeutic method for effectuating a behavior~~ modification by at least one of a living first person and a living second person, wherein the behavior modification relates to improving a relationship between the living first person and the living second person. A coffin is provided, wherein the coffin is visually available to the first person, and wherein the second person is in the coffin. See specification, page 3, line 20 - page 4, line 15; page 6, lines 12-13. The first person is directed to see the second person as being in the coffin. See specification, page 7, lines 10-11.

The first person is instructed to speak to the second person in relation to a relationship between the first person and the second person, wherein the second person is not acting in a theatrical performance, and wherein the second person is not rehearsing in preparation for acting in a theatrical performance. The first person may be instructed to speak to the second person of an emotion that the first person has for the second person. See specification, page 8, line 12 - page 9, line 4.

The directing and instructing steps may be performed by a facilitator. See specification, page 8, lines 4-5; page 9, lines 5-6. The facilitator may be a professional therapist or a member of the clergy. See specification, page 6, lines 8-10.

The pillow may be visually available to the first person. See specification, page 4, lines 14-16.

Atop end of the coffin may partially cover the coffin. See specification, page 5, lines 2-5.

The method may further comprise operating an electronic device, wherein the electronic device is located within the coffin. The electronic device may be selected from the group consisting of an audio device, a video device, and combinations thereof. See specification, page 4, lines 14-20.

The instructing step may include instructing the first person to speak to the second person of something selected from the group consisting of a love for the second person, a missing of the second person, an appreciation of what the second person did for the first person, a regret for having shown the second person disrespect, and a wish for a second chance to relate to the second person, and combinations thereof. See specification, page 8, line 15 - page 9, line 4.

After the instructing step, the first person may be questioned using questions having predetermined fixed responses and pertaining to the first person's attitude toward the second person. See specification, page 13, line 19 - page 14, line 12.

The method may further comprise directing the first person to envision himself or herself as being at his or her moment of despair (MOD) in relation to a destructive habit that the first person has. See specification, page 9, line 22 - page 10, line 2. The destructive habit may include a habitual practice selected from the group consisting of a habitual using of an illegal drug, a habitual smoking of tobacco, a habitual drinking of alcoholic beverages to a point of intoxication, a habitual aggressive driving of a motor vehicle, and a habitual showing of parent disrespect. See specification, page 9, lines 17 - 21

The method may further comprise conditioning the first person to use a trigger to induce a power thought in the first person. See specification, page 10, line 21 - page 11, line 1. The first person may be directed to pledge using the trigger for regularly inducing a power thought in the first person. See specification, page 11, lines 11 - 18.

Prior to administering the therapeutic method, the method may include determining whether to continue with the therapeutic method, wherein the determining includes questioning a first person using first questions having predetermined fixed responses, and evaluating the responses of the first person to the first questions. See specification, page 12, line 22 - page 13, line 13.

ISSUES

1. Whether claims 1, 4-8, 12-17 and 19-21 are unpatentable under 35 U.S.C. §102(b) over the reference “Death Visualization Therapy” by Arnold P. Nerenberg, PhD.
2. Whether claims 9-10 are unpatentable under 35 U.S.C. §103(a) over Death Visualization Therapy, by Arnold P. Nerenberg, PhD in view of Official Notice,
3. Whether the reference “Death Visualization Therapy” was published more than one year prior to the filing date of the present patent application.

GROUPING OF CLAIMS

With respect to Issue 2 *supra*, claims 9 and 10 stand and fall together.

With respect to Issue 3 *supra*, claims 1, 4-10, 12-17 and 19-21 stand and fall together.

With respect to Issue 1 *supra*, the claims are grouped as shown in Table 1.

Table 1

Group	Claims	Do Claims of Group Stand or Fall Together?
1	1, 4, 6, 12	Yes
2	7, 8	Yes
3	5, 13, 14, 15, 16, 17	No
4	19, 20	Yes
5	21	Yes

The claims of Group 2 do not stand and fall together with the claims of Group 1, because the claims of Group 2 include the following issue not present in any of the claims of Group 1: whether the reference “Death Visualization Therapy” teaches: “wherein the coffin includes a pillow that is visually available to the first person”.

Claim 5 of Group 3 does not stand and fall together with the claims of Groups 1-2, because claim 5 includes the following issue not present in any of the claims of Groups 1-2: whether the reference “Death Visualization Therapy” teaches: “wherein the directing and instructing steps are performed by a facilitator”.

Claim 13 of Group 3 does not stand and fall together with claim 5 of Group 3 and the claims of Groups 1-2, because claim 13 includes the following issue not present in claim 5 of Group 3 and any of the claims of Groups 1-2: whether the reference “Death Visualization

Therapy” teaches: “after the instructing step, questioning the first person using questions having predetermined fixed responses and pertaining to the first person's attitude toward the second person”.

Claim 14 of Group 3 does not stand and fall together with claims 5 and 13 of Group 3 and the claims of Groups 1-2, because claim 14 includes the following issue not present in claims 5 and 13 of Group 3 and any of the claims of Groups 1-2: whether the reference “Death Visualization Therapy” teaches: “directing the first person to envision himself or herself as being at his or her moment of despair (MOD) in relation to a destructive habit that the first person has”.

Claim 15 of Group 3 does not stand and fall together with claims 5 and 13-14 of Group 3 and the claims of Groups 1-2, because claim 15 includes the following issue not present in claims 5 and 13-14 of Group 3 and any of the claims of Groups 1-2: whether the reference “Death Visualization Therapy” teaches: “conditioning the first person to use a trigger to induce a power thought in the first person”.

Claim 16 of Group 3 does not stand and fall together with claims 5 and 13-15 of Group 3 and the claims of Groups 1-2, because claim 16 includes the following issue not present in claims 5 and 13-15 of Group 3 and any of the claims of Groups 1-2: whether the reference “Death Visualization Therapy” teaches: “directing the first person to pledge using a trigger for regularly inducing a power thought in the first person”.

Claim 17 of Group 3 does not stand and fall together with claims 5 and 13-16 of Group 3 and the claims of Groups 1-2, because claim 17 includes the following issue not present in claims 5 and 13-16 of Group 3 and any of the claims of Groups 1-2: whether the reference “Death Visualization Therapy” teaches: “wherein the destructive habit includes a habitual practice

selected from the group consisting of a habitual using of an illegal drug, a habitual smoking of tobacco, a habitual drinking of alcoholic beverages to a point of intoxication, a habitual aggressive driving of a motor vehicle, and a habitual showing of parent disrespect”.

The claims of Group 4 do not stand and fall together with the claims of Groups 1-3, because the claims of Group 4 include the following issue not present in any of the claims of Groups 1-3: whether the reference “Death Visualization Therapy” teaches: “prior to administering the therapeutic method, determining whether to continue with the therapeutic method, including questioning a first person using first questions having predetermined fixed responses, and evaluating the responses of the first person to the first questions”.

The claims of Group 5 do not stand and fall together with the claims of Groups 1-4, because the claims of Group 5 include the following issues not present in any of the claims of Groups 1-4: whether the reference “Death Visualization Therapy” teaches: “prior to administering the therapeutic method, determining whether to continue with the therapeutic method, including questioning a first person using first questions having predetermined fixed responses, and evaluating the responses of the first person to the first questions” and “after the instructing step, questioning the first person using second questions having predetermined ”.

ARGUMENT

Issue 1

CLAIMS 1, 4-8, 12-17 AND 19-21 ARE NOT UNPATENTABLE UNDER 35 U.S.C. §102(B) OVER THE REFERENCE “DEATH VISUALIZATION THERAPY” BY ARNOLD P. NERENBERG, PHD.

The Examiner rejected claims 1, 4-8, 12-17 and 19-21 under 35 U.S.C. §102(b) as allegedly being anticipated by the alleged reference “Death Visualization Therapy” by Arnold P. Nerenberg, PhD. Hereinafter, the reference of “Death Visualization Therapy” by Arnold P. Nerenberg, PhD is identified as the “DVT Reference”.

Claims 1 and 19

As to claim 1, the Examiner alleges: “Page 8 describes the provision of a coffin in a closed room for the purpose of conducting a psychological therapeutic method. As described on page 19, a first person (Joe's Mother) and a second person (Joe) and brought into the room. The second person (Joe) is directed to lay in the coffin. The first person (Joe's mother) can see the second person (Joe) in the coffin and is directed to speak to the second person (Joe) in regards to their personal relationship. Neither the first person or second personal are rehearsing or acting in a theatrical performance.” As to claim 19, the Examiner alleges: “See remarks for claim 1. Prior to the implementation of the method, both the first person (Joe's Mother) and the second person (Joe) are questioned (page 6, entire page)”.

Appellants respectfully contend that the DVT Reference does not anticipate claims 1 and 19, because the DVT Reference does not teach each and every feature of claims 1 and 19.

As a first example of why the DVT Reference does not anticipate claims 1 and 19, Appellants respectfully contend that the DVT Reference does not teach “wherein the coffin is visually available to the first person”. The Examiner has identified Joe’s mother as the first person and Joe as the second person. The Examiner cited page 8 of the DVT Reference, but on page 8 of the DVT Reference, Joe’s mother is not even mentioned. The Examiner cited page 19 of the DVT Reference, but page 19 of the DVT Reference does not teach that the coffin is visually available to Joe’s mother. In fact, page 19 of the DVT Reference does not teach that that Joe’s mother is in the same room as the coffin. Page 19 of the DVT Reference teaches only that Joe’s mother has the capability of speaking with Joe. Joe’s mother could engage in said audio communication with Joe without the coffin being visually available to her. For example, there could be an opaque partition between Joe’s mother and the coffin that block’s a view of the coffin from Joe’s mother. As a second example, Joe’s mother could be in another room and be in telephone or equivalent electronic communication with Joe. As a third example, the coffin could be in a closed room with no windows and no illumination wherein the room is pitch black such that the coffin is not visually available to anyone in the room. Appellants contend that there is absolutely no disclosure on page 10 of the DVT Reference that teaches that Joe is visually available to Joe’s mother. Accordingly, Appellants contend that claims 1 and 19 are not anticipated by the DVT reference.

As a second example of why the DVT Reference does not anticipate claims 1 and 19, Appellants respectfully contend that the DVT Reference does not teach “directing the first person to see the second person as being in the coffin”. Page 8 of the DVT Reference is not relevant to this feature because the first person (Joe’s mother) is not mentioned on page 8 of the

DVT Reference. On page 19 of the DVT Reference, the only direction received by Joe's mother is: "I would have ... had his mother speak what was in her heart" which does not teach "directing the first person to see the second person as being in the coffin". In other words, while page 19 of the DVT reference teaches directing Joe's mother to speak to Joe, page 19 of the DVT reference does not teach directing Joe's mother to see Joe as being in the coffin.

As a first additional matter specific to claim 19, Appellants respectfully contend that the DVT Reference does not teach the following feature of claim 19: "questioning a first person using first questions having **predetermined fixed responses**" (emphasis added). The Examiner alleges: "Prior to the implementation of the method, both the first person (Joe's Mother) and the second person (Joe) are questioned (page 6, entire page)." In response, Appellant's note that the only question asked of the first person (identified by the Examiner as Joe's mother) is: "Is that correct?" Mom's response is: "I would gladly give my kidney, my life, or anything he needs." Hence Appellants maintain that from the context of the preceding question and answer, the preceding question is not a question having a predetermined fixed response as required by claim 19.

As a second additional matter specific to claim 19, Appellants respectfully contend that the DVT Reference does not teach the following feature of claim 19: "**if the evaluating determines that the therapeutic method should continue**: providing ...; having...;directing...; and instructing" (Emphasis added). Appellants maintain that page 6 of the DVT Reference does not teach performing the additional method steps ("providing ...; having...;directing...; and instructing") **conditionally** based on whether "the evaluating determines that the therapeutic method should continue", as required by claim 19.

Based on the preceding arguments, Appellants respectfully maintain that does not anticipate claims 1 and 19, and that claims 1 and 19 are in condition for allowance.

Claim 4

Since claim 4 depends from claim 1, which Appellants have argued *supra* as not being unpatentable under 35 U.S.C. §102(b), Appellants maintain that claim 4 is likewise not unpatentable under 35 U.S.C. §102(b).

Claim 5

Since claim 5 depends from claim 1, which Appellants have argued *supra* as not being unpatentable under 35 U.S.C. §102(b), Appellants maintain that claim 5 is likewise not unpatentable under 35 U.S.C. §102(b).

In addition, the DVT Reference does not teach “wherein the directing and instructing steps are performed by a facilitator”.

The Examiner argues: “The steps are performed by a facilitator (page 9, lines 9-13)”.

In response, Appellants maintain that page 9 of the DVT Reference does not teach the step of directing the first person (Joe’s mother) to see the second person (Joe) as being in the coffin is performed by a facilitator (the therapist). Indeed, on page 9, of the DVT Reference, the therapist communicates only with Joe and does not communicate at all with Joe’s mother.

Therefore claim 5 is not anticipated by the DVT Reference.

Claim 6

Since claim 6 depends from claim 6, which Appellants have argued *supra* as not being unpatentable under 35 U.S.C. §102(b), Appellants maintain that claim 6 is likewise not unpatentable under 35 U.S.C. §102(b).

Claim 7

~~Since claim 7 depends from claim 1, which Appellants have argued *supra* as not being~~
unpatentable under 35 U.S.C. §102(b), Appellants maintain that claim 7 is likewise not unpatentable under 35 U.S.C. §102(b).

In addition, the DVT Reference does not teach “wherein the coffin includes a pillow that is visually available to the first person”.

The Examiner argues: “The coffin includes a visible pillow (page 8, line 3)”.

In response, Appellants maintain that page 8 of the DVT Reference does not teach the pillow is visually available to the first person (Joe’s mother). Indeed, Joe’s mother is never mentioned on page 8 of the DVT Reference.

Therefore claim 7 is not anticipated by the DVT Reference.

Claim 8

Since claim 8 depends from claim 7, which Appellants have argued *supra* as not being unpatentable under 35 U.S.C. §102(b), Appellants maintain that claim 8 is likewise not unpatentable under 35 U.S.C. §102(b).

Claim 12

Since claim 12 depends from claim 1, which Appellants have argued *supra* as not being unpatentable under 35 U.S.C. §102(b), Appellants maintain that claim 7 is likewise not unpatentable under 35 U.S.C. §102(b).

Claim 13

~~Since claim 13 depends from claim 1, which Appellants have argued *supra* as not being~~
unpatentable under 35 U.S.C. §102(b), Appellants maintain that claim 13 is likewise not unpatentable under 35 U.S.C. §102(b).

In addition, Appellants respectfully contend that the DVT Reference does not teach the following feature of claim 13: “after the instructing step, questioning the first person using questions having predetermined fixed responses and pertaining to the first person's attitude toward the second person”.

The Examiner argues: “Both the first person (Joe’s mother) and te second person (Joe) are questioned after the completion of the session (page 20, line 21: page 15, lines 19-27)”.

In response, Appellants maintain that on page 20 of the DVT Reference, there is no teaching that the first person (Joe’s mother) is questioned. Also in response, Appellants maintain that on page 15 of the DVT Reference, the first person (Joe’s mother) is asked the question: “Mom, how do you fee right now?”, which is not a question having a predetermined fixed responses as required by claim 13.

Therefore claim 13 is not anticipated by the DVT Reference.

Claim 14

Since claim 14 depends from claim 1, which Appellants have argued *supra* as not being unpatentable under 35 U.S.C. §102(b), Appellants maintain that claim 14 is likewise not unpatentable under 35 U.S.C. §102(b).

In addition, Appellants respectfully contend that the DVT Reference does not teach the following feature of claim 14: “directing the first person to envision himself or herself as being at ~~his or her moment of despair (MOD) in relation to a destructive habit that the first person has.~~”

The Examiner argues: “when the first person (Joe's Mother) is directed to speak to the second person (Joe), the first person (Joe's Mother) is speaking to Joe as if he had died and is laying in a coffin, which would be a moment of despair”.

In response, Appellants maintain that the Examiner's identified moment of despair (MOD) is not relation to a destructive habit that the first person (Joe's mother) has, as required by claim 14.

Therefore claim 14 is not anticipated by the DVT Reference.

Claim 15

Since claim 15 depends from claim 14, which Appellants have argued *supra* as not being unpatentable under 35 U.S.C. §102(b), Appellants maintain that claim 15 is likewise not unpatentable under 35 U.S.C. §102(b).

In addition, Appellants respectfully contend that the DVT Reference does not teach the following feature of claim 15: “conditioning the first person to use a trigger to induce a power thought in the first person.”

The Examiner argues: “The coffin used in the method serves as a trigger to induce specific thoughts leading to specific new behaviors”.

In response, Appellants maintain that the Examiner’s example does not relate to a “power thought”. Page 11, lines 1-3 of the specification defines “power thought” as follows: “ A ‘power thought’ in the first person 12 is a thought by the first person 12 that envisions the destructive habit as causing an adverse consequence to the first person 12.” Appellants contend that the Examiner’s example does not relate to a thought that envisions the destructive habit as causing an adverse consequence to the first person (Joe’s mother). Therefore, the Examiner’s example does not relate to a “power thought” and therefore has no relevance to claim 15.

Therefore claim 15 is not anticipated by the DVT Reference.

Claim 16

Since claim 16 depends from claim 14, which Appellants have argued *supra* as not being unpatentable under 35 U.S.C. §102(b), Appellants maintain that claim 16 is likewise not unpatentable under 35 U.S.C. §102(b).

In addition, Appellants respectfully contend that the DVT Reference does not teach the following feature of claim 16: “directing the first person to pledge using a trigger for regularly inducing a power thought in the first person”

The Examiner argues: “Both the first person (Joe's Mother) and the second person (Joe) are directed to make pledges (page 23, lines 11-12; page 17, lines 1-4; page 17 lines 13-19, page 28, line 7)”.

In response, Appellants maintain that the first person (Joe’s mother) is not discussed at all

on pages 17, 23, and 28. Also in response, no pledge discussed on pages 17, 23, and 28 is a pledge using a trigger for regularly inducing a power thought in the first person (Joe's mother), as required by claim 16.

Therefore claim 16 is not anticipated by the DVT Reference.

Claim 17

~~Since claim 17 depends from claim 14, which Appellants have argued *supra* as not being~~
unpatentable under 35 U.S.C. § 102(b), Appellants maintain that claim 17 is likewise not unpatentable under 35 U.S.C. § 102(b).

In addition, Appellants respectfully contend that the DVT Reference does not teach the following feature of claim 17: "wherein the destructive habit includes a habitual practice selected from the group consisting of a habitual using of an illegal drug, a habitual smoking of tobacco, a habitual drinking of alcoholic beverages to a point of intoxication, a habitual aggressive driving of a motor vehicle, and a habitual showing of parent disrespect".

The Examiner argues: "The destructive habit primarily described in the Death Visualization Therapy book is parental disrespect, but other behaviors such as drug use and road rage are discussed (page 28, lines 18-20)".

In response, Appellants maintain that the destructive habit of claim 17 is the destructive habit of the first person (Joe's mother) as seen from the antecedent basis of destructive habit in claim 14. Appellant's content that the DVT Reference does not disclose that Joe's mother has any of the destructive habits recited in claim 17.

Therefore claim 17 is not anticipated by the DVT Reference.

Claim 20

Since claim 20 depends from claim 19, which Appellants have argued *supra* as not being unpatentable under 35 U.S.C. §102(b), Appellants maintain that claim 20 is likewise not unpatentable under 35 U.S.C. §102(b).

Claim 21

~~Since claim 21 depends from claim 19, which Appellants have argued *supra* as not being~~
unpatentable under 35 U.S.C. §102(b), Appellants maintain that claim 21 is likewise not unpatentable under 35 U.S.C. §102(b).

In addition, Appellants respectfully contend that the DVT Reference does not teach the following feature of claim 21: “after the instructing step, questioning the first person using second questions having predetermined fixed responses and pertaining to the first person's attitude toward the second person”.

The Examiner argues: “See remarks for claim 13”.

In response, Appellants make reference to Appellants arguments relating to claim 13.

Issue 2

CLAIMS 9-10 ARE NOT UNPATENTABLE UNDER 35 U.S.C. §103(A) OVER DEATH VISUALIZATION THERAPY, BY ARNOLD P. NERENBERG, PHD IN VIEW OF OFFICIAL NOTICE.

The Examiner rejected claims 9-10 as allegedly being unpatentable under 35 U.S.C. §103(a) over Death Visualization Therapy, by Arnold P. Nerenberg, PhD in view of Official Notice. Hereinafter, the reference of “Death Visualization Therapy” by Arnold P. Nerenberg, PhD is identified as the “DVT Reference”.

Since claims 9-10 depend from claim 1, which Applicants have argued *supra* to be patentable under 35 U.S.C. §102(b), Appellants maintain that claims 9-10 are not unpatentable under 35 U.S.C. §103(a).

In addition, Appellants respectfully contend that the DVT Reference does not teach the following feature of claims 9 and 10: “operating an electronic device, said electronic device located within the coffin” (claim 9) and “wherein the electronic device is selected from the group consisting of an audio device, a video device, and combinations thereof” (claim 10).

The Examiner admits: “Claims 9-10 differ from the Visualization Therapy booklet in that the book does not specifically recite the presence of audio or video devices”. The Examiner argues: “Examiner takes Official Notice that the usage of audio or video devices to record the statements or behavior of individuals is very well known in psychology and psychotherapy.... It would have been obvious to one of ordinary skill in the art to modify the Death Visualization Therapy method in order to include recording devices so as to permit accurate recording and playback of the patient's behavior, as is well known in the art.”.

In response, Appellants contend that the Examiner has not supplied a legally persuasive

argument as to why a person of ordinary skill in the art would modify the DVT Reference by the Examiner's alleged Official Notice in relation to claims 9-10. In particular, established case law requires that the prior art must contain some suggestion or incentive that would have motivated a person of ordinary skill in the art to modify a reference or to combine references. See *Karsten Mfg. Corp. V. Cleveland Gulf Co.*, 242 F.3d 1376, 58 U.S.P.Q.2d 1286, 1293 (Fed. Cir. 2001) ("In holding an invention obvious in view of a combination of references, there must be some suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to select the references and combine them in a way that would produce the claimed invention."). See also *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984) ("The mere fact that the prior art could be so modified would not have made the motivation obvious unless the prior art suggested the desirability of the modification."). Appellant maintains that the Examiner has not made any showing of where the prior art suggests incorporation of an electronic device within a coffin. Thus, the Examiner has created a reason for the combination that the Examiner has not supported by the cited prior art. By not citing any suggestion or incentive in the prior art for incorporating an electronic device within a coffin, the Examiner has failed to establish a *prima facie* case of obviousness in relation to claims 9-10.

Therefore claims 9-10 are not unpatentable under 35 U.S.C. §103(a) over the DVT Reference in view of Official Notice.

Issue 3

THE REFERENCE “DEATH VISUALIZATION THERAPY” WAS NOT PUBLISHED MORE THAN ONE YEAR PRIOR TO THE FILING DATE OF THE PRESENT PATENT APPLICATION.

Hereinafter, the reference of “Death Visualization Therapy” by Arnold P. Nerenberg, PhD is identified as the “DVT Reference”.

Appellants respectfully dispute the Examiner’s allegation that the DVT Reference is a reference that could be used against the claims of the present patent 35 U.S.C. § 102(b). At issue is the date at which the DVT Reference became publicly available. The Examiner alleges that the date at which the DVT Reference became publicly available is March 20, 1999, based on the following argument: “The reference to Death Visualization Therapy is a booklet published by the inventor of record in the present application. Records from the U.S. Copyright Office indicate that a copyright for this booklet was registered on December 27, 1999. A copy of the copyright record obtained from the U.S. Copyright Office pertaining to this same booklet indicates publication on March 20, 1999. Since the publication date of March 20, 1999 is more than one year prior to the effective filing date of the present application, and meets the requirement of being "described in a printed publication" under 35 USC 102(b), the reference to Death Visualization Therapy is considered to be applicable as prior art under 35 USC 102(b).”

The Examiner additionally argues:

“The prior office action addressed a declaration under 37 CFR 1.132 submitted March 20, 2003. Applicant has now submitted a new declaration under 37 CFR 1.132 with the response of October 28, 2003. The new declaration includes seven points. Points 1-5 were already recited in the previous declaration submitted March 20, 2003, and thus do not need to be reconsidered. Points 6-7 are new points and are considered herewith.

Points 6-7 state the applicant filled out the copyright registration without any external assistance and that the recited date of publication in the copyright registration is

not correct. By including such statement applicant is suggesting that the Death Visualization Therapy prior art reference was not made available to the public more than one year prior to the effective filing date of the present application.

In filing a copyright registration that recites a date of publication, the copyright applicant must sign that copyright registration and attest that the information being provided is correct (See copy of applicant's original copyright registration submitted with applicant's response of February 3, 2003). Applicant is now stating that the information which was certified as-being correct is now considered as not being correct.

Since the copyright registration is considered to be prima facie evidence of a public disclosure, additionally supported by a verification by signature, applicant needs to provide factual evidence or actual proof that the assertion in the copyright registration is incorrect (Also see MPEP 716.01 ©), first paragraph.... "To be of probative value, any objective evidence should be supported by actual proof").

Examiner finds that there is no objective evidence, factual evidence or actual proof that supports a conclusion that the copyright registration is incorrect. If anything, applicant's own signature attesting to accuracy in the copyright registration certainly does not support a conclusion that the information in the copyright registration is inaccurate. As no other factual evidence or actual proof is available, examiner cannot conclude that subject matter affirmed by applicant as being true is no longer true. The affidavit under 37 CFR 1.132 is thus not effective in resolving the rejection under 35 USC 102(b)."

As a preface to Appellants' response to the preceding arguments by the Examiner, Appellants note that Appellants previously introduced relevant factual evidence as Exhibit A to Dr. Nerenberg's Declaration under 32 C.F.R. §1.132. Said relevant factual evidence is a receipt for 110 copies of the DVT Reference, dated December 22, 1999. The Examiner's arguments have not addressed said relevant factual evidence. The pertinence of said relevant factual evidence will discuss *infra*.

In response to the preceding arguments by the Examiner, Appellants respectfully contend that the date at which the DVT Reference became publicly available is after December 20, 1999, based on the following analysis, supported by the case of *Ex parte Research and Mfg. Co.*, 10 USPQ.2d 1657 (Bd. Pat. App. & Interferences March 9, 1989). In *Ex Parte Research and Mfg. Co.*, the Board reversed the Examiner's rejection of claims 1, 11, and 21 under 35 U.S.C.

§ 102(b) as allegedly being anticipated by a publication identified as the Sorvall bulletin. The basis for the Examiners rejection was that the Sorvall bulletin was listed on a copyright registration form as having a date of publication of June 2, 1969, which is more than one year prior to the filing of the patent application at issue. The Board's analysis for reversing of the Examiner's rejection is as follows:

"[T]he certificate of registration provides *prima facie* evidence that the Sorvall bulletin 26-29 was a 'printed publication' under the provisions of 35 USC 102(b).

However, the *prima facie* evidence may be rebutted by convincing factual evidence to the contrary. As rebuttal evidence, appellant has presented copies of a letter from Mr. Clutter to Dr. Christensen dated May 28, 1969 requesting that Dr. Christensen "review" a "supplementary bulletin detailing the FTS that John Evans wanted to take on his tour of Europe." Also of record is a return letter from Dr. Christensen to Mr. Clutter dated June 5, 1969 stating that Dr. Christensen had "taken the liberty of revising the text, and a copy of the revised version is enclosed." Attached to Dr. Christensen's letter is a copy of what is asserted to be the revision. Additionally, appellant has proffered an affidavit of Cyrus G. Lindgren dated September 5, 1987, in which Mr. Lindgren asserts that "Bulletin 26-69 was printed as preliminary product information for use within the company," and that "Bulletin 26-69 was not distributed to sales personnel of Ivan Sorvall, Inc. or others" because it had [*14] been "immediately criticized and revised by Dr. Christensen resulting in the preparation of Bulletin 28-69. Copies of Bulletin 26-69 were therefore of no use to the company and were destroyed." Mr. Lindgren also states that, with regard to the application for Copyright Registration A90038, that he "recalls that he did not, himself, prepare this application," and "states to the best of his knowledge that the June 2, 1969 date contained in Sections 4 and 11 of the application referring to the date of publication of Bulletin 26-69 is inaccurate. This Bulletin was never put into use or distributed . . ."

On the basis of the evidence before us, it seems apparent that the Sorvall Supplementary Bulletin 26-69 was only distributed within the company and to Dr. Christensen. Although there were apparently no restrictions placed on Dr. Christensen's use of the bulletin, Dr. Christensen was, in our view, within the employ of Ivan Sorvall, Inc., and therefore the bulletin apparently was never circulated or distributed outside the company or its employees. We refer to the letter of Dr. Christensen to Mr. Baranowski dated June 3, 1987 (Patent Owner's citation BI, Paper No. 11) as evidence [*15] of the relationship between Sorvall and Dr. Christensen. Dr. Christensen states in the penultimate paragraph

thereof that "[m]y financial arrangement with Sorvall was a 5% royalty on all FTS instruments sold for the first 5 years. After the 5 years were up, I had little further contact with Sorvall."

Thus, in view of the evidence before us, it appears that the Sorvall Supplementary Bulletin 26-69 was not "placed on sale, sold, or publicly distributed" (17 USC 26). Therefore, not only was the June 2, 1969 date "inaccurate" as the date of publication, but the Sorvall Supplementary Bulletin 26-69 was not even "published" under the meaning of the copyright laws. Therefore, we find that the evidence of record rebuts the *prima facie* evidence of the fact stated in item 4 of the application for registration of a claim to copyright that June 2, 1969 was the date of publication of the Sorvall Supplementary Bulletin-FTS 26-69."

Id. at 1660-61.

Thus, the Board first considered that the publication date on the copyright registration to be *prima facie* evidence of a date of publication of June 2, 1969 of the Sorvall bulletin. Then, the Board held that the date of June 2, 1969 was not the date of publication of the Sorvall bulletin, based on the rebuttal evidence submitted. For the present patent application, Appellants next provide arguments as to why an application of the Board's holding in *Ex parte Research and Mfg. Co.* leads to the conclusion that the date of publication of the DVT Reference used to reject claims of the present patent application does not have the publication date of March 20, 1999 listed on the DVT Reference copyright application.

The following rebuttal evidence was submitted in *Ex parte Research and Mfg. Co.*:

- 1) the letter from Mr. Clutter to Dr. Christiansen;
- 2) the return letter from Dr. Christiansen to Mr. Clutter; and
- 3) Mr. Lingren's affidavit.

Similarly, Appellants have offered the following rebuttal evidence:

- 1) a receipt for 110 copies of the DVT Reference dated December 22, 1999 filed on October 28, 2003 as Exhibit A to Dr. Nerenberg's Declaration under 32 CF.R. §1.132; and
- 2) Dr. Nerenberg's Declaration under 32 CF.R. §1.132 filed on October 28, 2003 with Appellants' office action response.

Appellants submit that Appellants' rebuttal evidence item 1) (receipt for 100 copies) is analogous to rebuttal evidence items 1) and 2) in *Ex parte Research and Mfg. Co.* (Letter and return letter). For both cases (i.e., *Ex parte Research and Mfg. Co.* and the instant patent application) said rebuttal evidence does not rigorously prove that the publication at issue was not published on the date of publication listed on the copyright application. The letter and return letter in *Ex parte Research and Mfg. Co.* is merely indicative of an allegation that the original copy existing on June 2, 1969 was edited after June 2, 1965, but does not rigorously prove that the original copy existing on June 2, 1969 was not publicly available on June 2, 1969. Similarly, the receipt for 100 copies in the instant case does not rigorously prove that the copy of the DVT reference existing on March 20, 1999 was not publicly available on March 20, 1999. Nonetheless, the rebuttal evidence items 1) and 2) in *Ex parte Research and Mfg. Co.* were considered by the Board as persuasive as providing evidence on non-publication, even though said rebuttal evidence items 1) and 2) do not negate the possibility that the Sorvall publication could have been publicly available on June 2, 1969. Similarly, the receipt for the 100 copies in the instant case is evidence in support of a need to make the DVT reference publicly available after December 20, 1999, since it is normal practice to publish multiple copies of a book when making a book publicly available.

Moreover, with only a single copy existing on March 20, 1999 it is reasonable to suppose that the author Dr. Nerenberg would want to keep the single copy (and only existing copy) for himself until such time that other copies could be made for available or distribution to others. In any event, Appellants respectfully maintain that the receipt for the 100 copies in the instant case is at least as persuasive (as rebuttal evidence) as is items 1) and 2) in *Ex parte Research and Mfg. Co.* Thus, Appellants respectfully submit that the receipt for the 100 copies in the instant case is sufficiently persuasive, based on *Ex parte Research and Mfg. Co.*

Appellants additionally submit that Appellants' rebuttal evidence item 2) (Declaration under 32 CF.R. §1.132) is analogous to rebuttal evidence item 3) in *Ex parte Research and Mfg. Co.* (Mr. Lingren's affidavit). First, Mr. Lingren's affidavit asserts that the Sorvall Bulletin was not distributed to sales personnel of Ivan Sorvall, Inc. or others. Similarly, Dr. Nerenberg's Declaration asserts that the single copy of the DVT Reference was not publicly distributed or made publicly available. Second, Mr. Lingren's affidavit asserts that Mr. Lingren did not prepare the copyright application. Analogously, Dr. Nerenberg asserts that Dr. Nerenberg prepared the copyright application himself without the assistance or advice of legal counsel and that he mistakenly thought that the date of publication on the copyright application meant the date of printing. Appellants maintain that Dr. Nerenberg's Declaration is probably more persuasive than Mr. Lingren's affidavit, since Mr. Lingren did not produce any evidence that the person who filled out the copyright application was under a mistaken impression that the date of publication on the copyright application meant something other than the date of public availability. Yet, the Board found Mr. Lingren's affidavit to be persuasive. In any event, Appellants respectfully maintain that Dr. Nerenberg's Declaration in the instant case is at least persuasive (as rebuttal evidence) as is

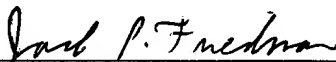
Mr. Lingren's affidavit in *Ex parte Research and Mfg. Co.* Thus, Appellant's respectfully submit that Dr. Nerenberg's Declaration in the instant case is sufficiently persuasive, based on *Ex parte Research and Mfg. Co.*

Based on the preceding arguments, Appellants respectfully contend that the holding in the *Ex parte Research and Mfg. Co.* case supports Appellants' contention that the DVT Reference cannot be used as prior art against the claims in the present patent application.

SUMMARY

In summary, Appellant respectfully requests reversal of the rejection of claims 1, 4-10, 12-17 and 19-21.

Respectfully submitted,



Jack P. Friedman
Attorney For Appellant
Registration No. 44,688

Dated: 05/24/2004

Schmeiser, Olsen & Watts
3 Lear Jet Lane - Suite 201
Latham, New York 12110
(518) 220-1850

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Nerenberg *et al.*

Examiner: Rimell, S.

Serial No.: 09/584,610

Art Unit: 2175

Filed: 5/31/00

For: **DEATH VISUALIZATION THERAPY**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPENDIX - CLAIMS ON APPEAL

1. A therapeutic method for effectuating a behavior modification by at least one of a living first person and a living second person, said behavior modification relating to improving a relationship between the living first person and the living second person, comprising the steps of:
 - providing a coffin, wherein the coffin is visually available to the first person;
 - having the second person in the coffin;
 - directing the first person to see the second person as being in the coffin; and
 - instructing the first person to speak to the second person in relation to a relationship between the first person and the second person, wherein the second person is not acting in a theatrical performance, and wherein the second person is not rehearsing in preparation for acting in a theatrical performance.

4. The method of claim 1, wherein the instructing step includes instructing the first person to speak to the second person of an emotion that the first person has for the second person.
5. The method of claim 1, wherein the directing and instructing steps are performed by a facilitator.
6. The method of claim 5, wherein the facilitator is selected from the group consisting of a professional therapist and a member of the clergy.
7. The method of claim 1, wherein the coffin includes a pillow that is visually available to the first person.
8. The method of claim 7, wherein a top end of the coffin partially covers the coffin.
9. The method of claim 1, further comprising operating an electronic device, said electronic device located within the coffin.
10. The method of claim 9, wherein the electronic device is selected from the group consisting of an audio device, a video device, and combinations thereof.
12. The method of claim 1, wherein the instructing step includes instructing the first person to speak to the second person of something selected from the group consisting of a love for the

second person, a missing of the second person, an appreciation of what the second person did for the first person, a regret for having shown the second person disrespect, and a wish for a second chance to relate to the second person, and combinations thereof.

13. The method of claim 1, further comprising after the instructing step, questioning the first person using questions having predetermined fixed responses and pertaining to the first person's attitude toward the second person.

14. The method of claim 1, further comprising directing the first person to envision himself or herself as being at his or her moment of despair (MOD) in relation to a destructive habit that the first person has.

15. The method of claim 14, further comprising conditioning the first person to use a trigger to induce a power thought in the first person.

16. The method of claim 14, further comprising directing the first person to pledge using a trigger for regularly inducing a power thought in the first person.

17. The method of claim 14, wherein the destructive habit includes a habitual practice selected from the group consisting of a habitual using of an illegal drug, a habitual smoking of tobacco, a habitual drinking of alcoholic beverages to a point of intoxication, a habitual aggressive driving of a motor vehicle, and a habitual showing of parent disrespect.

19. A therapeutic method for effectuating a behavior modification by at least one of a living first person and a living second person, said behavior modification relating to improving a relationship between the living first person and the living second person, comprising the steps of:

prior to administering the therapeutic method, determining whether to continue with the therapeutic method, including questioning a first person using first questions having predetermined fixed responses, and evaluating the responses of the first person to the first questions; and

if the evaluating determines that the therapeutic method should continue:

providing a coffin, wherein the coffin is visually available to the first person;

having the second person in the coffin;

directing the first person to see the second person as being in the coffin; and

instructing the first person to speak to the second person in relation to a relationship between the first person and the second person.

20. The method of claim 19, wherein the instructing step includes instructing the first person to speak to the second person of an emotion that the first person has for the second person.

21. The method of claim 19, further comprising after the instructing step, questioning the first person using second questions having predetermined fixed responses and pertaining to the first person's attitude toward the second person.